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09/611,835	07/07/2000	Brent R. Stockwell	50164/002002	6924

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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/611,835
Filing Date: July 07, 2000
Appellant(s): STOCKWELL ET AL.

Paul T. Clark
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/15/20060 appealing from the Office action mailed 3/21/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,985,214

Stylli et al.

11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. Claims 89-156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stylli et al. (US Patent 5,985,214).

Stylli et al. teaches an automated method and system for identifying chemicals having useful activity such as biological activities of chemicals and collecting informations resulting from such a process (col. 6, lines 1-24). The method comprise of testing a therapeutic chemical for modulating activity of a target such as cell surface proteins in a cell based assay (col. 38, lines 46-67; col. 39, lines 1-9; col. 43, lines 6-9). The method comprises dispensing the reagents (compounds) into the addressable sample wells, which contains a predetermined volume of the sample (test cells) (col. 6, lines 25-40; col. 8, lines 14-18). The method can individually screen at least 25,000 selected and discrete chemicals or chemical libraries wherein the chemicals are structurally related base on activity relationships (i.e. a combination of compounds) (col. 37, lines 44-51). Various method of detection of the compound interaction with the target includes fluorescent measurement such as FRET (fluorescence resonance energy transfer) (col. 27, lines 29-35; col. 28, lines 15-17; col. 39, lines 1-67 thru col. 42, lines 1-23).

The method of Stylli et al. does not expressly disclose that the chemical compounds tested are forty-nine unique combinations of seven different compounds.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include testing of forty-nine unique combinations of seven different compounds in the method of Stylli et al. One of ordinary skill in the art would have been motivated to include testing of forty-nine unique combinations of seven different compounds in the method of Stylli et al. because the number of combinations of compounds to be tested for the affect of biological property would be a choice of experimental design and is considered within the purview of the cited prior art. Additionally, it has been held that “[w]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA1955). Furthermore, one of ordinary skill in the art would have had a reasonable expectation of success in testing of forty-nine unique combinations of seven different compounds in the method of Stylli et al. since the taught method would need no modification other than increasing the amount of compound combinations that do not materially affect the method steps.

(10) Response to Argument

2. Claims 89-156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stylli et al. (US Patent 5,985,214).

DISCUSSION

Appellant has regrouped the claims of the rejection and argue each group separately.

For Group I (Claims 89-108, 110, 112-129, 131, 133-145, 147, 149, 150, and 152), appellants argue that the reference of Stylli et al. does not teach or suggest screening combinations of compounds because the examiner misinterprets the single sentence in Stylli et

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al., i.e. *“In practicing the methods of the invention, the products or compositions can be used alone or in combination with one another, or in combination with other therapeutic or diagnostic agents”*, as referring to the methods of screening. Thus, the reference of Stylli et al. does not teach or suggest screening combinations of compounds.

Appellants' arguments have been considered but are not persuasive because the reference of Stylli et al. does suggest screening combinations of compounds. It is the examiner's position is that Stylli et al. disclose several different methods for identifying useful chemicals, i.e. screening methods, (see col. 37, line 1 thru col. 38, line 67) wherein one such method is the method for developing a therapeutic chemical, i.e. method for screening therapeutic chemical, (see col. 38, lines 57-67). Although these methods are directed to screening individual chemical, the single sentence in Stylli et al., i.e. *“In practicing the methods of the invention, the products or compositions can be used alone or in combination with one another, or in combination with other therapeutic or diagnostic agents”* (see col. 44, lines 20-23), would such suggest screening combinations of compounds because the phrase *“In practicing the methods of the invention”* does not exclude the screening methods disclosed in Stylli et al. The examiner concur that the verb “to use” is not synonymous for “to screen”, but it is also not synonymous for “to treat” as suggested by appellants. The verb “to use” does means “employed”, which would encompass both the screening methods and the methods of treatment. Moreover, the disclosure of the screening methods precedes this sentence in Stylli et al. would imply that the interpretation of the phrase *“In practicing the methods of the invention”* would encompass the screening methods disclosed in Stylli et al. Consequently, the reference of Stylli et al. does render the methods of the instant claims *prima facie* obvious, and the rejection should be maintained.

For Group II (Claims 109, 111, 130, 132, 146, 151, and 153), appellants contend that [1] the reference of Stylli et al. does not teach or suggest screening combinations of compounds because the examiner misinterprets the single sentence in Stylli et al., i.e. *“In practicing the methods of the invention, the products or compositions can be used alone or in combination with one another, or in combination with other therapeutic or diagnostic agents”*, as referring to the methods of screening; and [2] the reference of Stylli et al. does not teach or suggest screening combinations of compounds wherein at least of the compounds is an FDA-approved drug as claimed in these claims (Claims 109, 111, 130, 132, 146, 151, and 153). Hence, the reference of Stylli et al. does not teach or suggest screening combinations of compounds.

Appellants’ arguments have been considered but are not persuasive because the reference of Stylli et al. does suggest screening combinations of compounds for the following reasons:

[1] It is the examiner’s position that the reference of Stylli et al. does suggest screening combinations of compounds for the reasons as fully discussed in Group I above.

[2] It is the examiner’s position that the reference of Stylli et al. does suggest screening combinations of compounds wherein at least of the compounds is an FDA-approved drug as claimed in these claims (Claims 109, 111, 130, 132, 146, 151, and 153). Although Stylli et al. does not explicitly disclose “FDA-approved drug”, the single sentence in Stylli et al., i.e. *“In practicing the methods of the invention, the products or compositions can be used alone or in combination with one another, or in combination with other therapeutic or diagnostic agents”*, would such suggest screening combinations of compounds because the phrase *“in combination with other therapeutic or diagnostic agents”* would suggest that suggest screening combinations of compounds wherein at least of the compounds is an ‘FDA-approved drug’. Moreover, the

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instant claimed methods recite methods for identifying chemicals for 'useful activity' wherein the chemicals are compositions of compounds (see instant claimed step (d) of claims 89, 114, 135, and instant claimed step (f) of claim 154) and not 're-screening' the 'FDA-approved drug'.

As a result, the phrase (i.e. "to identify chemicals with useful activity") in Stylli et al. as indicated by appellant does not imply a teaching away from the instant claimed methods.

Furthermore, the advantage cited in the instant specification regarding the use of combinations of compounds wherein at least of the compounds is an FDA-approved drug has no relevance with regard to the rejection over Stylli et al. Therefore, the reference of Stylli et al. does render the methods of the instant claims *prima facie* obvious, and the rejection should be maintained.

For Group III (Claims 154-156), appellants allege that [1] the reference of Stylli et al. does not teach or suggest screening combinations of compounds because the examiner misinterprets the single sentence in Stylli et al., i.e. "*In practicing the methods of the invention, the products or compositions can be used alone or in combination with one another, or in combination with other therapeutic or diagnostic agents*", as referring to the methods of screening; and [2] the reference of Stylli et al. does not teach or suggest that before the combination of compounds are tested, the compound is individually for activity as claimed in claim 154.

Appellants' arguments have been considered but are not persuasive because the reference of Stylli et al. does suggest screening combinations of compounds for the following reasons:

[1] It is the examiner's position that the reference of Stylli et al. does suggest screening combinations of compounds for the reasons as fully discussed in Group I above.

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[2] It is the examiner's position that the reference of Stylli et al. does suggest screening the compounds individually for activity and screening the combination of compounds for activity. Stylli et al. disclose several different methods for identifying useful chemicals, i.e. screening methods, (see col. 37, line 1 thru col. 38, line 67) wherein one such method is the method for developing a therapeutic chemical, i.e. method for screening therapeutic chemical, (see col. 38, lines 57-67). Stylli et al. suggest screening combinations of compounds (see col. 44, lines 20-23) and the composition include chemical identified by the disclosed methods (see col. 43, line 11-13). Consequently, the reference of Stylli et al. does render the methods of the instant claims *prima facie* obvious, and the rejection should be maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Examiner: My-Chau Tran




Conferees:

Supervisory Patent Examiner Peter Paras, Jr.

Supervisory Patent Examiner Andrew Wang

**PETER PARAS, JR.
PRIMARY EXAMINER**

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